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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/820,054

03/28/2001

Adam R. Schran

10397-1U1

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05/15/2006

AKIN GUMP STRAUSS HAUER & FELD L.L.P.
ONE COMMERCE SQUARE
2005 MARKET STREET, SUITE 2200
PHILADELPHIA, PA 19103

EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2161

DATE MAILED: 05/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,054

Applicant(s)

SCHRAN ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Claims Status

Claims 1-30 are pending. Claims 1-30 are rejected as detailed below.

Requirements for Information

Pursuant to 37 CFR 1.105 (3) Applicant is requested to provide the following factual information. In Declaration of Prior Invention to Overcome Cited Patent per 37 CFR 1.131 filed 4/11/2006, Applicant states the following on page 3:

8. The beta and commercial version of ActivePrivacy both contained all of the functionality of the limitations shown in Exhibit 5. General descriptions of such functionality are given in Exhibits 2 and 3.

9. ActivePrivacy is the commercial name of a software product associated with the presently claimed invention as further evidenced by Figs. 4 and 6 of the present invention which show screen shots labeled with Active Privacy.

Applicant is requested to provide earliest date of the commercial version and/or earliest date of public use of the software product Active Privacy.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claims 1-30 are rejected under 35 U.S.C. 102(b) as being anticipated by ActivePrivacy

¹

Claims 1-30:

ActivePrivacy provides all of the functionality of the claim limitations per Declaration of Prior Invention to Overcome Cited Patent (37 CFR 1.131) filed 4/11/2006.

Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat No 5,991,878 issued to McDonough et al (hereafter McDonough).

Claims 1 and 16:

McDonough provides:

- (a) receiving at a server a request from a subscriber to send a list of cookie file sources [smart cookies, col 2, lines 57-67]
- b) downloading the list [smart cookies, col 2, lines 57-67]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [access is prevented by using smart cookies, col 1 lines 57-67]

Claims 1 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Norton Internet Security 2000 [hereafter NIS 2000]².

Claims 1 and 16:

NIS 2000 provides:

¹ Refer Attachment 1, Ascentive Website of Feb 29, 2000, and Attachment 2, Internet Archive WaybackMachine

² Symantec Bundles Safe Surfing Tools – Alexandra Krasne, discloses Norton Internet Security 2000 scheduled to ship at the end of November, 1999.

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- (a) receiving at a server a request from a subscriber to send a list of cookie file sources [Jay - Black website list]³
- b) downloading the list [free updates - Jay]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [NIS can block cookies – Jay]

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2002/0055912 issued to Buck (hereafter Buck).

Claims 1 and 16:

Buck discloses:

- a) receiving at a server [e-Privacy site 24, Fig 1B, e-Privacy software 26, Fig 1B, paragraph 43] a request from a subscriber [PC 12, Fig 1B, paragraph 43, computer user guaranteed privacy, paragraph 39] to send a list [member of e-Privacy network, paragraph 45, e-Privacy list of vendor members, paragraph 58] of cookie file sources [vendor sends cookie, paragraph 45] to the client machine [user PC 12, Fig 1B, paragraph 43]

³ Norton Internet Security 2000 – Review by Julien Jay

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- b) downloading the list from the server to the client machine [process of verification and authentication occurs during each session, paragraph 45]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [disposition of the cookie, paragraph 45]

Claim 2 and 17:

Buck discloses (d) creating a first exception list including the identity of sources that are permitted to store cookies in the client machine [members of e-Privacy network, paragraph 22] (e) creating a second exception list including the identity sources that are not permitted to store cookie files in the client machine [inherent in the following: paragraph 51 discloses because cookies are tracked and paragraphs 45 and 48 discloses a member list], (f) modifying the downloaded list in accordance with the first and second exception lists [list of members is updated, paragraph 58]

Claims 3, 9, 18 and 24:

Buck discloses receiving updates of the downloaded list from the server on a periodic basis [paragraph 58]

Claim 4 and 19:

Buck discloses displaying a message at the client machine indicating that a cookie file received from a source on the downloaded list has been detected [paragraph 44]

Claims 5, 10, 14, 20, 25 and 29:

Buck discloses (d) removing the detected cookie file stored in the client machine [paragraph 46]

Claims 6, 11, 15, 21, 26 and 30:

Buck discloses preventing detecting cookie files from being stored in a client [paragraph 46].

Claims 7 and 22:

Buck discloses (a) creating a first exception list including the identity of sources that are permitted to store cookie files in the client machine [member of e-Privacy network, paragraph 45, e-Privacy list of vendor members, paragraph 58] , (b) creating a second exception list including the identity of sources that are not permitted to store cookie files in the client machine [inherent in the following: paragraph 51 discloses because cookies are tracked and paragraphs 45 and 48 discloses a member list], (c) receiving at the client machine, from a service provider, a master list of cookie file sources [paragraph 51 discloses because cookies are tracked], (d) modifying the master list in accordance with the first and second exception lists, wherein the complete list is the modified master list [list of members is updated, paragraph 58].

Claims 8 and 23 and 28:

Buck discloses wherein the composite list is stored in the client machine independent of the first exception list, the second exception list and the received master list [paragraph 43]

Claims 12 and 27:

Buck discloses

(a) receiving at the client machine, from the service provider, a master list of file sources [all cookies, paragraph 51], (b) deleting cookie file sources from the master list that correspond to one or more trusted file cookie file sources listed in the client machine [list of vendor members, paragraph 58], (c) adding cookie file sources to the master list that correspond to one or more untrusted file sources listed in the client machine, wherein the composite list is the

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master list as modified by any additions and deletions of trusted and untrusted cookie file sources [inherent in the all cookies list minus the vendor member list].

Claim 13:

Buck discloses the master list and the composite list are stored independently in the client machine [paragraph 43]

Claims 1 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat No 6,678,731 issued to Howard et al (hereafter Howard).

Claims 1 and 16:

Howard discloses:

- a) receiving at a server [authentication server, col 7, lines 25-40] a request from a subscriber [user, col 7, lines 25-40] to send a list [list of all web sites or servers, col 7, lines 25-40] of cookie file sources [col 7, lines 25-40]
- b) downloading the list from the server to the client machine [col 7, lines 25-40]
- c) using the downloaded list to detect files received at the client machine from sources on the downloaded list [col 7, lines 25-40]

Response to Arguments

Applicant's arguments filed 4/11/2006 have been considered and not are persuasive for the reasons given below.

Applicant Argues:

Applicant provides a Declaration of Prior Invention to Overcome cited patent 37 C.F.R. § 1.131. Applicant states on page 2 that facts and documentary evidence establish completion of the invention before October 20, 2002.

Examiner Responds:

Examiner is not persuaded. The MPEP requires applicant to show conception and reduction to practice of the invention.

The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the October 20, 2000 reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Applicant does not even mention conception of the invention.

The evidence submitted is insufficient to establish applicant's alleged actual reduction to practice of the invention in this country or a NAFTA or WTO member country before the effective date of the October 20, 2000 reference.

Exhibit 4 is an e-mail from a customer of ActivePrivacy. The customer complains that the "ActivePrivacy program is virtually useless." Examiner is not convinced that above statement shows reduction to practice of the invention.

Furthermore, Applicant provides Exhibit 1 to support reduction to practice before October 20, 2000. Exhibit 1 is essentially not readable. What can be ascertained from Exhibit 1 is a listing of dates when modifications occurred on various ActivePrivacy files. As best

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examiner can ascertain, the modifications to ActivePrivacy are still continuing as no indication is included in Exhibit 1 of any stages of completeness. No notes are provided to the software updates such that one of normal skill in the art would be able to deduce that at least one of the updates is special such that reduction to practice can be ascertained. Providing a list of undated modifications is not prove or even vaguely suggest reduction to practice before October 20, 2000 of the present invention.

Furthermore, Exhibit 2 – Intellectual Property Needs Assessment by Adam Schran is not consistent with the invention claimed in claim 1. Exhibit 2 includes A “Watchlist” of sites that use cookie file sources to store unique or identifying information. Furthermore, Exhibit 2 states that the end user has a Blacklist and furthermore, the end-user has a Trustlist. Claim 1 claims downloading a list of cookie file sources from a server to a client. The list of cookie file sources in Claim 1 can be compared to the Watchlist of Exhibit 2. The Blacklist and the Trustlist of Exhibit 2 are not included in Claim 1. Obviously, because the inventive concept of Exhibit 2 and the inventive concept of Claim 1 are different, Exhibit 2 cannot provide support for reduction to practice of the invention as claimed in claim 1.

Applicant Argues:

Applicant states on page 3 that NIS 2000 does not disclose the claim 1 limitation “list of cookie file sources.”

Examiner Responds:

Examiner is not persuaded. Above Office action clearly maps above claim limitation to NIS 2000.

Applicant Argues:

Applicant states on pages 4 and 5 that the “list” as disclosed by Howard is not the same as in the present invention.

Examiner Responds:

Examiner is not persuaded. Consider the following excerpt from the MPEP:

MPEP § 2106. II.C Review the Claims:

Office personnel must rely on the applicant’s disclosure to properly determine the meaning of terms used in the claims. *Markman v. Westview Instruments*, 52 F.3d 967, 980, 34 USPQ2d 1321, 1330 (Fed. Cir.) (*en banc*), *aff’d*, U.S. 116 S. Ct. 1384 (1996). An applicant is entitled to be his or her own lexicographer, and in many instances will provide an explicit definition for certain terms used in the claims. Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim. *Toro Co. v. White Consolidated Industries Inc.*, 199 F.3d 1295, 1301, 53 USPQ2d 1065, 1069 (Fed. Cir. 1999) (meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawings.”).

Office personnel must always remember to use the perspective of one of ordinary skill in the art. Claims and disclosures are not to be evaluated in a vacuum. If elements of an invention are well-known in the art, the applicant does not have to provide a disclosure that describes those elements. In such a case the elements will be construed as encompassing any and every art-recognized hardware or combination of hardware and software technique for implementing the defined requisite functionalities.

Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. *In re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPAQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 13201322

(Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonable allow

Applicant does not particularly point to the specification for an explicit definition of the term "list." Examiner maintains that the list as disclosed by Howard is the same as the list disclosed by Applicant.

Contact Information

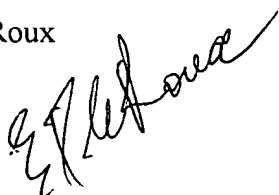
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne P. LeRoux whose telephone number is (571) 272-4022. The examiner can normally be reached Monday through Friday between 8:00 am and 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is (571) 273 8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Etienne LeRoux

5/11/2006

A handwritten signature in black ink, appearing to read 'E. LeRoux', is written over the typed name and date.